

Applicants: David M. Stern, et al.
U.S. Serial No.: 08/905,709
Filed: August 5, 1997
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REMARKS

Claims 1-4, 8, 9, 15-18, 36, 37 and 46 are pending and under examination, and claims 40-45 are withdrawn, in the subject application. Claim 1 has been amended in order to more particularly point out what the applicants consider to be the invention. Support for this amendment may be found *inter alia* in the specification of priority application 08/592,070 ('070 application) at page 11, lines 28 and 29 and page 13, lines 21 to 32. Applicants maintain that the amendment of claim 1 raises no issue of new matter and is fully supported by the specification. Applicants have also canceled claims 17, 18, 36, 37 and 40-45 without prejudice. Applicants respectfully request that this Amendment be entered. Upon entry of this Amendment, claims 1-4, 8, 9, 15, 16 and 46 will be pending and under examination.

Claim of Priority

The Examiner asserts that the subject matter defined in claims 1-4, 8, 9, 15-18, 36, 37 and 46 has an effective filing date of August 5, 1997, which is the filing date of the subject application. The 08/592,070 application ("070 application"), filed on January 26, 1996, allegedly fails to provide adequate support under 35 U.S.C. §112 for the instantly claimed invention.

Specifically, the Examiner alleges that the '070 application provides no support for a "derivative" of sRAGE as claimed in the instant application.

In response, and without conceding the correctness of the

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Examiner's position, applicants note that claim 1, as amended, does not recite the term "derivative" with respect to sRAGE.

Accordingly, applicants maintain that the '070 application provides adequate support under 35 U.S.C. §112 for the subject matter of pending claims 1-4, 8, 9, 15, 16 and 46, as amended. As a result, the subject matter of these claims is entitled to an effective filing date of January 26, 1996, which is the filing date of the '070 application. Applicants again note that rejected claims 17, 18, 36 and 37 have been canceled, rendering the Examiner's remarks moot with respect thereto.

Rejection under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1-4, 8, 9, 15-18, 36, 37 and 46 under 35 U.S.C. §112, second paragraph, as allegedly failing to comply with the written description requirement.

Specifically, the Examiner alleges that the applicants do not provide a definition of a "derivative" or disclose any derivative in the instant application. The Examiner further alleges that derivatives of sRAGE encompass a huge number of substitutions, insertions, deletions, mutations and an attachment of modifying groups of sRAGE.

In response to the Examiner's rejection, but without conceding the correctness thereof, applicants again point out that claim 1, as amended, does not recite the term "derivative" with respect to sRAGE. Accordingly, the Examiner's rejection of claim 1, and dependent claims 2-4, 8, 9, 15, 16 and 46, is obviated. Applicants

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again note that rejected claims 17, 18, 36 and 37 have been canceled, rendering the Examiner's rejection thereof moot.

In view of the above remarks, applicants maintain that claims 1-4, 8, 9, 15, 16 and 46 satisfy the requirements of 35 U.S.C. §112, first paragraph.

Rejection Under 35 U.S.C. §102(e)

The Examiner rejected claims 1-4, 8, 9, 15-18, 36, 37 and 46 under 35 U.S.C. 102(e) as allegedly anticipated by U.S. Patent No. 5,864,018 ("Morser"). Applicants understand this rejection to apply only to claims 1-4, 8, 9, 15, 16 and 46, as the remaining rejected claims have been canceled.

Applicants contend that the claimed invention is entitled to a priority date of January 26, 1996 as discussed above. Therefore, since Morser is only available as a reference as of April 16, 1996, i.e. after the January 26, 1996 effective filing date of the claimed invention, Morser is not available as a §102(e) reference.

In view of the above remarks, applicants maintain that claims 1-4, 8, 9, 15, 16 and 46 satisfy the requirements of 35 U.S.C. §102(e).

Summary

For the reasons set forth hereinabove, applicants respectfully request that all pending claims of this application be allowed, and that the application proceed to issuance.

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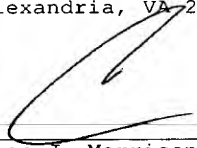
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee, other than the \$60.00 extension fee, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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